



Atty Dkt. 2002.00506

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: MATTHEWS, William H.
PENN, Ian M., et al.)
: Group Art Unit: 3738
Appln. No. 10/849,990)
: Confirmation No.: 8691
Filed: May 21, 2004)
: April 21, 2006
For: EXPANDABLE STENT AND)
METHOD FOR DELIVERY :
OF SAME)

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

**STATEMENT RE LITIGATION AND
INFORMATION DISCLOSURE STATEMENT**

Sir:

Applicants respectfully submit the attached documents for the Examiner's consideration in this application.

MPEP 2001.06(c) suggests that Applicants advise the USPTO when "the subject matter for which a patent is being sought is or has been involved in litigation, the existence of such litigation and any other material information arising therefrom."

1. On January 28, 2002, an entity named IsoStent sued, among others, the then-assignee of a predecessor of the subject application, DivYsio Solutions ULC, and the inventors of the subject application, Drs. Penn and Ricci, in a California state court, alleging, *inter alia*, misappropriation of trade secrets by DivYsio and Drs. Penn and Ricci¹. No claim was made under the patent statutes, 35 USC. That litigation proceeded to trial, which concluded in late 2004 with a complete vindication of DivYsio and Drs. Penn and Ricci, by the Jury and then by the trial Judge sitting in equity².

While Applicants believe that the subject matter of the present application was not involved in that litigation, out of an overabundance of caution, and without any admission that any of the disclosed information is "material" within the meaning of 37 CFR 1.56, Applicants hereby make of record the existence of that litigation together with certain relevant documents therefrom. Out of consideration for the Examiner, all of the voluminous files of that litigation are not being submitted herewith. However, should the Examiner wish to see any other documentation related to the litigation (for example, discovery materials such as Interrogatories, Document Requests, Requests for Admissions, and any responses thereto), such will be provided promptly (subject to the provisions of the Protective Order in that case). Further, the undersigned remains available for personal and/or telephone interviews should the Examiner believe that such would assist him in his examination of the subject application.

¹ See the *IsoStent LLP v. LPL Systems, Inc. et al.* Complaint, attached.

² See, for example, the *Court's Judgment After Jury Verdict and Order Granting Defendants DivYsio Solutions ULC, Ian Penn and Donald Ricci's Costs as the Prevailing Parties*, attached.

2. On February 15, 2006, the assignee of the subject application, evYsio Medical Devices ULC, among others, filed a patent infringement suit against Advanced Cardiovascular Systems, Inc., et al.³ In that suit, plaintiffs allege, *inter alia*, infringement of U.S. Patent No. 6,858,037, which although not directly related to the present application, shares a common disclosure and drawings therewith and claims priority to the same four Canadian patent applications.

Without any admission that the subject matter of the present application is involved in this litigation, or that any of the disclosed information is “material” within the meaning of 37 CFR 1.56, Applicants hereby make of record the existence of this litigation together with certain relevant documents therefrom. Likewise, all of the litigation documents will not be submitted herewith, out of consideration for the Examiner. Again, should the Examiner wish to see any other documentation related to the litigation, such will be provided promptly (subject to the provisions of any Protective Order in that case). Likewise, the undersigned remains available for personal and/or telephone interviews should the Examiner believe that such would assist him in his examination of the subject application. Lastly, since this litigation is still ongoing, Applicants may supplement this Statement and Information Disclosure Statement from time to time.

3. Applicants also wish to advise the Examiner of the following patents and pending patent applications which, while not directly related to the subject

³ See *Medtronic Vascular, Inc., v. Advanced Cardiovascular Systems, Inc.* Answer, attached

application, share a common disclosure and drawings therewith and claim priority to the same four Canadian patent applications:

USP 6,217,608, issued April 17, 2001;

USP 6,375,677, issued April 23, 2002;

USP 6,858,037, issued February 22, 2005;

USP 6,881,223, issued April 19, 2005;

USP 6,887,264, issued May 3, 2005;

USP 6,796,997, issued September 28, 2004;

USAN 10/850,397, filed May 21, 2004; and

USAN 10/761,459, filed January 22, 2004.

Pursuant to 37 C.F.R. §1.56 and in accordance with the practice under 37 C.F.R. §§1.97 and 1.98, the Examiner's attention is directed to the attached documents listed on the attached Forms PTO/SB/08A and PTO/SB/08B. It is respectfully requested that the attached information be considered by the Examiner and that a copy of the attached Forms PTO/SB/08A and PTO/SB/08B be returned indicating that such information has been considered.

In accordance with 37 C.F.R. § 1.97(b)(4), this Information Disclosure Statement is being filed concurrently with a Request for Continued Examination under § 1.114. It is believed that neither a certificate, petition nor payment of a fee is required for this Information Disclosure Statement. However, the Commissioner is hereby authorized to charge any fee which may be required in connection with this paper to Deposit Account No. 50-1710.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3500. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard P. Bauer", written over a horizontal line.

Attorney for Applicants
Richard P. Bauer
Registration No. 31,588

PATENT ADMINISTRATOR
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661-3693
Facsimile: (312) 902-1061

Complete if Known

(Use as many sheets as necessary)

Sheet	1	of	5
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Application Number	10/849,990
Filing Date	May 21, 2004
First Named Inventor	Ian M. Penn
Art Unit	3738
Examiner Name	William H. Mathews
Attorney Docket Number	213202-00506

[illegible][illegible]Date
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND**

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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

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Sheet 2 of 5

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		Complaint for Misappropriation of Trade Secrets, Breach of Contract, Breach of the Implied Duty of Good Faith and Fair Dealing, Inducement of Contract and Unjust Enrichment for Case No. CV 804863 in the Superior Court for the State of California in and for the City of Santa Clara, January 28, 2002	
		Judgment After Jury Verdict for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, September 24, 2004	
		Order Granting Defendants Divysio Solutions ULC, Ian Penn and Donald Ricci's Costs As The Prevailing Parties for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, November 18, 2004	
		First Amended Complaint for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, March 21, 2002	
		Second Amended Complaint for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, April 15, 2002	
		Deposition of Donald Ricci for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, December 19, 2002	
		Deposition of Ian Penn for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, January 15, 2003	
		Videotaped Deposition of Dr. Robert E. Fischell, Volume I, for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 5, 2003	
		Deposition of Richard Press for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, December 12, 2003	
		Deposition of Donald Ricci for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, December 17, 2003	

Examiner Signature		Date Considered	
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		Deposition of Ian Penn for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, December 18, 2003	
		Continued Videotaped Deposition of Dr. Robert E. Fischell, Volume I, for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, January 15, 2004	
		Deposition of George Adolph Shukov for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, Volume I, pp. 1-257, February 9, 2004	
		Deposition of George Adolph Shukov for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, Volume II, pp. 258-361, February 10, 2004	
		Reporter's Transcript of Proceedings for Hearing on Motion for Summary Judgment for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, March 2, 2004	
		Order for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, March 2, 2004	
		Amended Order for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, March 17, 2004	
		Defendants Divysio Solutions ULC, Donald Ricci and Ian Penn's Trial Brief for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 23, 2004	
		Trial Brief of Plaintiff Isostent, LLC for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 23, 2004	
		Selected Pages from Trial Exhibits for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 23, 2004, all document numbers beginning with "L0"	

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SignatureDate
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		Transcript of Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 24, 2004	
		Transcript of Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 28, 2004	
		Transcript of Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, August 31, 2004	
		Transcript of Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, September 1, 2004	
		Transcript of Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, September 2, 2004	
		Transcript of Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, September 3, 2004	
		Fax Cover page and Isostents's Notice of Motion And Motion For New Trial for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, October 18, 2004	
		Declaration of Alicia N. Vaz In Support Of Defendants' Joint Opposition To Plaintiff's Motion for Equitable Relief for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, November 18, 2004	
		Transcript of Hearing on Motions for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, November 18, 2004	
		Isostent, LLC's Reply In Support Of Its Motion for Equitable Relief for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, November 18, 2004	

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		Defendants' Joint Opposition To Plaintiff Isostent, LLC's Motion for Equitable Relief; Declaration of Alicia N. Vaz for Case No. CV 1-02-804863 in the Superior Court for the State of California in and for the City of Santa Clara, November 18, 2004	
		Answer and CounterClaims of Advanced Cardiovascular Systems, Inc. and Guidant Sales Corporation for Case No. C-06-01066 (PJH) in the United States District Court for the Northern District of California, San Francisco Division, April 6, 2006	
		First Amended and Supplemental Complaint for Patent Infringement And Declaratory Judgement Relief for Case No. C-06-01066 (PJH) in the United States District Court for the Northern District of California, San Francisco Division, April 6, 2006	
		Minutes of the Oral Proceedings before the European Patent Office Board of Appeal for European Patent No. EP 97904958.2, March 3, 2006	

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